

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS GUERET

Appeal No. 98-1848
Application 08/500,781¹

ON BRIEF

Before CALVERT, STAAB and LALL, *Administrative Patent Judges*.
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 2 to 22, all the claims then pending in the application. Subsequent to the final rejection, claims 2, 6,

¹ Application for patent filed July 11, 1995.

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10, 14, and 16 to 20 were canceled by an amendment filed July 14, 1997 (Paper No. 16). Accordingly, only the final rejection of claims 3 to 5, 7 to 9, 11 to 13, 15, 21, and 22 remains before us for review.²

As a preliminary matter, we note that the subject matter and issues presented in the instant appeal are similar to those presented in related Appeal No. 98-1019 in appellant's application Serial No. 08/500,782, which related appeal is decided concurrently herewith.

Appellant's invention is directed to an applicator for applying a make-up product. The subject matter before us on appeal is reproduced in an appendix to the brief.

The references of record relied upon by the examiner in support of rejections under 35 U. S. C. § 103 are:

Cabot	3,271,807	Sept. 13, 1966
Gueret	4,927,281	May 22, 1990
Guerret	5,020,551	Jun. 4, 1991
Beck et al. (Beck)	5,107,870	Apr. 28, 1992
Dahm (British Patent Document)	2,082,553	Mar. 10, 1982

² Another amendment filed subsequent to the final rejection on March 14, 1997 (Paper No. 10) has not been entered.

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Cole 2,159,699
(British Patent Document)

Dec. 11, 1985

The following rejections under 35 U. S. C. § 103 are
before us for review:³

- (1) claims 3, 4, 21, and 22, unpatentable over Cole in view
of Beck and Cabot; and
- (2) claims 5, 7 to 9, 11 to 13, and 15, unpatentable over
Cole in view of Beck and Cabot, and further in view of Dahm,
Guerret and Guerret.

The rejections are explained in the examiner's answer
(Paper No. 17, mailed November 4, 1997).

The opposing viewpoints of appellant are set forth in the
brief (Paper No. 15, filed July 14, 1997).

³ In the final rejection, claim 21 was also rejected
under 35 U.S.C. § 112, second paragraph, as being indefinite.
In that the answer does not contain a restatement of this
rejection, we assume it to have been withdrawn by the
examiner. See *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App.
1957).

OPINION

At the outset, we have encountered substantial difficulty in understanding the metes and bounds of the appealed claims.

Starting with the requirement of independent claim 22 that the applicator includes an application member of "predetermined flexibility," we have had difficulty in determining what this term encompasses. The specification gives no meaningful explanation of how the flexibility of the application member is to be determined, much less what constitutes a "predetermined" flexibility.⁴ In this regard, the specification gives broad ranges for the number, length, and thickness of the bristles that may make up the application member, as well as examples of the cross-sectional shape, surface treatment and material of the bristles, all of which would appear to have an impact on the flexibility of the application member. However, the specification is silent as to how these variables affect flexibility.

⁴ At oral hearing, counsel for appellant was understood to say that the term "predetermined" was meaningless, could be ignored, and could just as easily have been deleted from the claim. We decline to read this term out of the claim, if that was counsel's intent.

Our next difficulty with claim 22 stems from the recitation that the applicator includes a stem "having substantially said predetermined flexibility" (i.e., having substantially the same flexibility as the application member). On its face, this claim language may appear to be reasonably clear. However, no claim may be read apart from and independent of its supporting disclosure, and claim language which otherwise appears to be definite may take on an unreasonable degree of uncertainty when read in light of the supporting specification. *In re Cohn*, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971); *In re Moore*, 439 F.2d 1232, 1235 n.2, 169 USPQ 236, 238 n.2 (CCPA 1971). Moreover, the term "substantially" is a word of degree. When a word of degree is used in a claim, it is necessary to determine whether the specification provides some standard for measuring that degree. *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

In the present case, we find no standard or guidelines whatsoever in appellant's specification to determine to what

extent the flexibility of the stem may depart from the flexibility of the application member and yet be regarded as having "substantially" the same flexibility as the application member. In particular, the discussion on page 4 of the specification as to what constitutes a stem having flexibility "similar to" that of the application member does not suffice in this regard. This is so because the statement on page 4 that the flexibility of the stem is chosen so that the relationship $0.3f < F < 3f$ is satisfied, where F is the force to be applied to bend the stem and f is the force necessary to bend the application member, is so broad that it cannot be seriously considered a reasonable standard or guideline for determining the scope of the word "substantially" in line 4 of claim 22.

An additional source of confusion is the recitation in claim 22 which reads "whereby upon applying the product to a surface, the stem and the application member form a curve with a substantially constant curvature." It is not clear whether this recitation sets forth (1) an additional requirement of the applicator above and beyond that called for in the first

four lines of the claim, (2) a definition of what constitutes a flexibility of the stem that is "substantially" the same as the predetermined flexibility of the application member, or (3) a result that flows from the structure called for earlier in the claim. As to (3), depending on the extent of departure between the flexibilities of stem and application member allowed by the word "substantially" in line 4 of the claim, it would seem that the stated result may or may not flow from a given application member/elongated stem combination.

Turning to claim 21, it is well established that the transitional phrases "consisting of" and "including" linking the preamble and body of a claim have special meanings in patent law. Specifically, "consisting of" signifies that the claim covers only devices having the recited elements and no more, while "including" signifies that the claim is open-ended and does not exclude the presence of other elements not mentioned. *In re Certain Slide Fastener Stringers and Machines and Components Thereof for Producing Such Slide Fastener Stringers*, 216 USPQ 907, 915 (U.S. Int'l Trade Comm. 1981); *Ex parte Davis*, 80 USPQ 448, 449-50 (Bd. App. 1949).

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Based on these special meanings, the transitional phrase "consisting of" in line 1 of claim 21 is inconsistent with the requirement found in the last two lines of the claim that the application assembly thereof "is provided with an applicator in accordance with claim 22." This is so because claim 22 is in the open "including" format and therefore does not exclude the presence of other elements.

Another difficulty with claim 21 stems from the term "application member" appearing in line 3 thereof. It is not clear whether this application member is the same as, or distinct from, the "application member" of the claim 22 device incorporated by reference into claim 21. Additionally, the term "the storage position" (claim 21, lines 3 to 4) lacks a proper antecedent basis, such that it is not clear what position constitutes the storage position. Also, it is not clear what the word "it" (claim 21, line 5) refers to.

A last difficulty arises from claim 15, which depends ultimately from claim 22. It is not understood how bristles having slight corrugations over at least part of their length, as required by claim 15, can define an applicator wherein "the stem and the application member form a curve with a

substantially constant curvature," as called for in claim 22.⁵

While we might speculate as to what is meant by the claim language discussed above, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obligated to do.

Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of terms employed and assumptions as to the scope of such claims." *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Accordingly, we are constrained to reverse the examiner's rejections of the appealed claims as being unpatentable over the prior art. We hasten to add that this is a procedural reversal rather than one based upon the merits of the rejections. We take no position as to the pertinence of the prior art as applied by

⁵ At oral hearing, counsel for appellant was understood to say that the recitations of claim 15 were inconsistent with the "whereby" clause of claim 22, and that claim 15 should be canceled.

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the examiner in his rejections.

Pursuant to our authority under 37 CFR 1.196(b), we make the following new rejection.

Claims 3 to 5, 7 to 9, 11 to 13, 15, 21, and 22 are rejected under 35 U.S.C. § 112, second paragraph.

The purpose of the second paragraph of 35 U. S. C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). For the reasons stated above, the appealed claims fail in this purpose in that they do not set forth the subject matter sought to be patented with a reasonable degree of precision and accuracy.

As a final point, we note that the examiner has mentioned that "German Patent #425254 has been made of record, but not applied in the rejection" (answer, page 3) and that "the Board of Appeals has the discretion to apply this reference" (answer, page 4). Presumably, the examiner has drawn our

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attention to this reference in the hope that it might form the basis of a new ground of rejection under 37 CFR § 1.196(b) in the event we were to reverse the standing rejections on the merits. This "back door" approach of introducing a new issue on appeal is inappropriate. However, since the examiner has raised the issue, and since appellant has addressed this reference in the brief on page 5, it would be appropriate, in the event of further prosecution, for the examiner to state on the record his position with respect to the relevance of the German reference to the claimed subject matter.

In summary, the standing rejections have been reversed on procedural grounds, and a new rejection of the appealed claims pursuant to 37 CFR § 1.196(b) has been entered.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant,

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WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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